

REMARKS

The Office Action dated February 13, 2007 has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

Claims 28-54 are respectfully submitted for consideration.

Applicants submit that the finality of the present Office Action is premature and respectfully requests withdrawal of the finality of the Office Action.

MPEP 7607 states that “present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.

In the present case, the claim amendments that were submitted in the Response that was filed on January 11, 2007, merely removed the word “step” and corrected typographical informalities. Therefore, these amendments did not altered the scope of the claims or otherwise necessitate the finality of the Office Action. Thus, the present Final Office Action prematurely cuts-off Applicants right to clearly define the presently claimed invention.

Further, MPEP 706.7(a) states that a second or any subsequent action on the merits shall be final except where the examiner introduces new ground of rejection that is neither necessitated by applicants amendment of the claims nor based on information

submitted in an information disclosure statement in the time period set forth in 37 C.F.R. 1.97(c) with the fee set forth in 37 CFR 1.17(p) (underline added).

In the present case, the Final Office Action introduces a new ground of rejection and a new reference (Brescia). Neither the new grounds of rejection, nor the newly applied reference was necessitated by amendments discussed above i.e., deleting the term “steps”. Thus, the finality of the Office Action was not necessitated by the previous amendments and is therefore, premature.

In light of the above, withdrawal of the finality of the Office Action is respectfully requested.

The Office Action rejected claims 28-52 and 54 under 35 U.S.C. 102(e) as being anticipated by US Patent No. 7, 068,189 to Brescia et al. (Brescia). This rejection is respectfully traversed.

Claim 28, from which claims 29-40 depend, is directed to a method of providing a profile to a mobile terminal. A profile to a specific event is allocated. An association of a mobile terminal with the event is detected. The profile is transmitted to the mobile terminal.

Claim 41, from which claims 42-53 depend, is directed to an application server configured to provide an event specific profile to at least one mobile terminal. A first communications interface is configured to provide a mobile network with event specific information. A second communications interface is configured to receive details of a mobile terminal associated with the event specific information. A third communications

interface is configured to transmit the event specific profile to the mobile terminal associated with the event specific information.

Claim 54 is directed to a communication system configured to provide event specific profiles to mobile terminals. An application server is associated with the event. A mobile communication network is configured to receive event specific characteristics from the application server. At least one mobile terminal is configured to connect to the network. The mobile network notifies the application server if the mobile terminal is associated with the event, and when responsive thereto the application server transmits the event specific profile to the mobile terminal.

Applicants submit that each of the above claims recites features that are neither disclosed nor suggested in Brescia.

Brescia is directed to delivering information, such as a notification or other content, to a select communication device when defined event and location criteria are satisfied. A profile is established to define the event and location criteria along with a method for delivering the information. Typically, the receipt of event indicia indicating the occurrence of an event is compared with the event criteria in the profile. When the event indicia satisfies the event criteria, location indicia is gathered and compared with the defined location criteria. Alternatively, a trigger corresponding to location is received and compared with the location criteria before determining whether an event corresponding to the event criteria is satisfied. When both the event occurrence and location indicia match the event and location criteria, the information is sent to the

appropriate communication device. See column 3 lines 44-47, column 4 lines 24-26, and column 4 lines 51-54 of Brescia.

Applicants respectfully submit that Brescia fails to disclose or suggest at least the feature of transmitting said profile to said mobile terminal, as recited in claim 28 and similarly recited in claims 41 and 54. As discussed above, Brescia merely discloses sending “information” to the appropriate device, if the event occurrence and location indicia match the event and location criteria. Specifically, Brescia states a profile that defines information, and this information and not the profile is transmitted to a select device, when predefined events and location indicia are satisfied, wherein the profile is stored on an application server. See column 4 lines 46-50 of Brescia. Thus, the “profile” is sent to an application server and not to a device. Further, the “information” that is sent to a select device, such as a notification or other content, is not a “profile” as defined in the present claimed invention. Thus, in Brescia, the profile is not sent to a device, only the resulting information, if a match occurs. This is further evidenced in Figs. 4 and 5 of Brescia which illustrate that the profile is stored in a separate database/server and is not transmitted to the mobile device. See col. 7 lines 10-14 and 52-55 of Brescia.

MPEP 2173.01 states that a “fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. See MPEP § 2111.01. Applicant may use functional language, alternative expressions,

negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.” However, in the present case, the Office Action is essentially denying Applicants’ right to define the invention using the term “profile” by ignoring the meaning of that term.

Applicants submit that because claims 29-40 and 49-52 depend from claims 28 and 41, these claims are allowable at least for the same reasons as claims 29 and 41, as well as for the additional features recited in these dependent claims.

Based at least on the above, Applicants submit that Brescia fails to disclose or suggest all of the features recited in claims 28-52 and 54. Accordingly, withdrawal of the rejection under 35 U.S.C. 102(e) is respectfully requested.

The Office Action rejected claim 53 under 35 U.S.C. 103(a) as being obvious over Brescia. The Office Action took the position that Brescia disclosed all of the features of these claims except the third interface being a GPRS or Bluetooth interface. The Office Action took Official Notice that this feature is well known in the art. This rejection is respectfully traversed. Specifically, Applicants submit that Brescia is deficient at least for the reasons discussed above regarding claim 41.

Further, Applicants respectfully traverse the Office Action’s use of Official Notice. Applicants respectfully request evidence that the use of GPRS or a Bluetooth

interface is well-known in the art when applied as a third interface to an application server.

Based at least on the above, Applicants submit that Brescia and the Official Notice taken in the Office Action, fail to disclose or suggest all of the features of claim 53. Accordingly, withdrawal of the rejection under 35 U.S.C. 103(a) is respectfully requested.

Applicants submit that each of claims 28-54 recites features that are neither disclosed nor suggested in any of the cited references. Accordingly, it is respectfully requested that each of claims 28-54 be allowed, and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D E Brown", written over a horizontal line.

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